GP/3634

PATENT- NO FEE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

D Nash 2/6/02

In Re: Application of MICHAEL L. SCHWEISS	)	
Serial No.: 09/783,960	)	
Filed: February 20, 2001	)	Group Art Unit 3634
For: METHOD OF OPENING AND CLOSING A BI-FOLD DOOR	)	Exr. B. Johnson
Case Docket No.: S339.12.2	)	

LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed are the Declaration of Michael L. Schweiss and Schweiss brochures, Exhibits A and B, concerning the commercial importance and success of the claimed method and apparatus for opening and closing a bi-fold door. Schweiss Distributing, Inc. has in the last three (3) years sold 952 bi-fold doors with sales of $5,622,343 having the apparatus and method claimed in this patent application. These substantial sales of bi-fold doors are material evidence of the commercial success of the claimed apparatus and method. Under 35 U.S.C. 103 commercial success of an invention must be considered in resolving the obviousness of the claimed apparatus and method of opening and closing a bi-fold door.

The relevant portion of 35 U.S.C. 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

A judgment of obviousness requires that a determination as whether the claimed invention would have been obvious based on underlying factual inquiries, including: 1) the scope and content of the prior art, 2) the level of skill in the ordinary art, 3) the differences between the claimed invention and the prior art, and 4) secondary considerations of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966). *Monarch Knitting Machine Corp. v. Sulzer Morat GMBH*, 139 F.3d, 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998).

Secondary considerations, such as long-felt need, commercial success, and initial expressions of disbelief by experts, should be considered in every case for whatever probative value they have and are not limited to cases where patentability is a "close" question. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983). As the Federal Circuit has explained,

> [O]bjective evidence such as commercial success, failure of others, long-felt need, and unexpected results must be considered before a conclusion on obviousness is reached. . . . Indeed, as then Chief Judge Markey said in *Stratoflex, Inc. v. Aeroquip Corp.* . . . "evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art is not." In spite of the importance that the secondary considerations of commercial success, long felt need, and failure of others played in the considerations of both the PTO and [trial court], [the infringer] conspicuously fails to address them.

Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 U.S.P.Q.2d 1321 (Fed. Cir. 1992).

Applicant requests that the Declaration of Michael L. Schweiss and Exhibits A and B be considered along with the amendment filed November 1, 2001, and that Claims 1 to 20 be

allowed.

Respectfully submitted,

MICHAEL L. SCHWEISS

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on December 3, 2001
(Date of Deposit)

RICHARD O. BARTZ
Name of ~~applicant~~, assignee, or Registered Rep.

Richard O. Bartz
Signature

December 3, 2001
Date of Signature